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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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Steve Leibowitz

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EXAMINER

FIELDS, BENJAMIN S

ART UNIT

PAPER NUMBER

3692

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PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No. 10/821,118	Applicant(s) LEIBOWITZ, STEVE	
	Examiner BENJAMIN S. FIELDS	Art Unit 3692	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 08 April 2004.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-20 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-20 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 08 April 2004 is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date <u>See Continuation Sheet</u> . | 6) <input type="checkbox"/> Other: _____ |

Continuation of Attachment(s) 3). Information Disclosure Statement(s) (PTO/SB/08), Paper No(s)/Mail Date :7 July 2004; 15 August 2005; 10 April 2006.

DETAILED ACTION

Double Patenting

The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the “right to exclude” granted by a patent and to prevent possible harassment by multiple assignees. A nonstatutory obviousness-type double patenting rejection is appropriate where the conflicting claims are not identical, but at least one examined application claim is not patentably distinct from the reference claim(s) because the examined application claim is either anticipated by, or would have been obvious over, the reference claim(s). See, e.g., *In re Berg*, 140 F.3d 1428, 46 USPQ2d 1226 (Fed. Cir. 1998); *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) or 1.321(d) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent either is shown to be commonly owned with this application, or claims an invention made as a result of activities undertaken within the scope of a joint research agreement.

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

1. Claims 1-20 of **this** instant application conflict with Claims 1-29 of pending Application No. 11/005,311.

37 CFR 1.78(b) provides that when two or more applications filed by the same applicant contain conflicting claims, elimination of such claims from all but one application may be required in the absence of good and sufficient reason for their retention during pendency in more than one application. Applicant is required to either cancel the conflicting claims from all but one application or maintain a clear line of demarcation between the applications. See MPEP § 822.

2. Claims 1-20 are provisionally rejected as claiming the same invention as that of

the copending Application. This is a provisional statutory obviousness-type double patenting rejection since the conflicting claims have not in fact been patented. Although the conflicting claims are not identical, they are not patentably distinct from each other because they claim the same if not very similar inventive concept.

Appropriate correction is required.

Drawings

3. The drawings are objected to because **Figures 2-10 are very difficult to read/interpret/reproduce**. Corrected drawing sheets in compliance with 37 CFR 1.121(d) are required in reply to the Office action to avoid abandonment of the application. Any amended replacement drawing sheet should include all of the figures appearing on the immediate prior version of the sheet, even if only one figure is being amended. The figure or figure number of an amended drawing should not be labeled as “amended.” If a drawing figure is to be canceled, the appropriate figure must be removed from the replacement sheet, and where necessary, the remaining figures must be renumbered and appropriate changes made to the brief description of the several views of the drawings for consistency. Additional replacement sheets may be necessary to show the renumbering of the remaining figures. Each drawing sheet submitted after the filing date of an application must be labeled in the top margin as either “Replacement Sheet” or “New Sheet” pursuant to 37 CFR 1.121(d). If the changes are not accepted by the examiner, the applicant will be notified and informed of any required

corrective action in the next Office action. The objection to the drawings will not be held in abeyance.

Claim Rejections - 35 USC § 102

4. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

5. Claims 1-5, and 7-20 are rejected under 35 U.S.C. 102(e) as being anticipated by Gilbert et al. (US PG Pub. No. 2003/0088501), [hereinafter Gilbert].

Referring to Claim 1: Gilbert teaches a computerized trading system for facilitating transactions of financial instruments between a plurality of traders, said computerized trading system comprising: a bid and offer recorder connected in communication with the traders and configured to record a plurality of bids and offers from the traders, each of the bids and offers having transaction information including at least a price, a quantity and a type of financial instrument; a matching engine connected in communication with the bid and offer recorder and capable of receiving the bids and offers from the bid and offer recorder, said matching engine configured to compare the bids and offers and to match bids with offers using the price, quantity and type of financial instrument associated with each of the bids and offers; and a trade restrictor

connected in communication with the bid and offer recorder and the matching engine, wherein the trade restrictor is configured to receive the bids and offers from the bid and offer recorder, detect at least one of the bids and offers that is automated and restrict booking of the automated one of the bids and offers (Gilbert: Abstract; Page 1, Paragraphs 0006-0009; See Claims).

Referring to Claim 2: Gilbert discloses a computerized trading system, wherein the transaction information also includes a source identity and wherein the trade restrictor is further configured to restrict booking of the automated bids and offers based on the source identity (Gilbert: Page 1, Paragraphs 0008-0010).

Referring to Claim 3: Gilbert shows a computerized trading system, wherein the trade restrictor is further configured to restrict booking of the automated bids and offers by restricting matching, by the matching engine, of bids and offers which are automated and which originate from a market maker as described by the source identity (Gilbert: Figure 1; Page 1, Paragraphs 0008-0012).

Referring to Claim 4: Gilbert discusses a computerized trading system, wherein the transaction information of each of the bids and offers includes automation data indicating that the bid or offer is automated and wherein the trade restrictor is configured to find the automation data and to block matching, by the matching engine, of bids and offers when the automation data indicates one of the bids and one of the offers of a potential match are automated (Gilbert: Figure 1; Page 1, Paragraphs 0011-0012).

Referring to Claim 5: Gilbert teaches a computerized trading system, wherein the transaction information includes cancellation data and wherein the trade restrictor is

further configured to determine if the cancellation data requests cancellation of a previous bid or offer which indicates automation of the bid or offer of the potential match (Gilbert: Figures 1, 2, 5; Page 2, Paragraph 0028; Page 3, Paragraph 0029; Page 5, Paragraph 0057).

Referring to Claim 7: Gilbert shows a computerized trading system, wherein the transaction information also includes re-price information configured to replace a price of a previous bid or offer (Gilbert: Page 1, Paragraph 0006-Page 4, Paragraph 0039).

Referring to Claim 8: Gilbert discusses a computerized trading system, wherein the trade restrictor is configured to restrict booking of the automated bids and offers by restricting submission of the automated bids and offers to the bid and offer recorder by the traders (Gilbert: Abstract; Page 1, Paragraphs 0006-0009; See Claims).

Referring to Claim 9: Gilbert teaches a computerized trading system, wherein the trade restrictor is configured to restrict booking of the automated bids and offers by restricting matching of the automated bids and offers by the matching engine (Gilbert: Page 3, Paragraphs 0029-0036).

Referring to Claim 10: Gilbert discloses a computerized trading system, wherein the trade restrictor is configured to restrict booking of bids and offers only when both the bid and the offer of a potential match are automated (Gilbert: Page 3, Paragraphs 0029-0036).

Referring to Claims 11-15: Claims 11-15 are the method for the system of Claims 1-5 and 7-10. As such, Claims 11-15 are rejected under the same basis as are Claims 1-5 and 7-10 as mentioned supra.

Referring to Claims 16-20: Claims 16-20 are directed towards a computer program product for the system of Claims 1-5 and 7-10. As such, Claims 16-20 are rejected under the same basis as are Claims 1-5 and 7-10 as mentioned supra.

Claim Rejections - 35 USC § 103

6. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

7. Claim 6 is rejected under 35 U.S.C. 103(a) as being unpatentable over Gilbert in view of Merold et al. (US PG Pub. No. 2004/0019554), [hereinafter Merold].

Referring to Claim 6: Gilbert discloses the limitations of Claim 1.

Gilbert, however, does not expressly show a system wherein automated bids and offers are generated from an automated price feed of another trading platform.

Merold, in a similar environment discusses a system wherein automated bids and offers are generated from an automated price feed of another trading platform (Merold: Abstract; Figure 1; Page 1, Paragraph 0009; Page 3, Paragraphs 0055-0060).

At the time of the invention it would have been obvious to one of ordinary skill in the art to modify the method of Gilbert for trading in an exclusive market with the disclosure of Merold for an automated trading system with the ability to intercept/access

the price feed of another trading platform for the purpose of providing a customer with the “best price” trading information (Merold: Page 1, Paragraph 0007).

Conclusion

8. Any inquiry concerning this communication should be directed to BENJAMIN S. FIELDS at telephone number 571.272.9734. The examiner can normally be reached MONDAY through THURSDAY, 9AM to 7PM. If attempts to reach the examiner by telephone are unsuccessful, the examiner’s supervisor, KAMBIZ ABDI can be reached at (571) 272-6702. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

Benjamin S. Fields
20 March 2008

/Frantzy Poinvil/
Primary Examiner, Art Unit 3692